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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,187	03/08/2001	Kazuyuki Yokokawa	3385-US-B1	4101
63543 7590 09/22/2009 AVERY DENNISON CORPORATION Patent Group Law Department - 3 South P.O. BOX 7090 PASADENA, CA 91109-7090				
EXAMINER CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
09/22/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

09/801,187

**Applicant(s)**

YOKOKAWA, KAZUYUKI

**Examiner**

VICTOR S. CHANG

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2009 and 17 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 181-183,185,186,188-193,197-200,202-212,214,215,217-225,227-234,237-242,244-254,256,257,259-264 and 269-272.

Continuation of Disposition of Claims: Claims rejected are 181-183,185,186,188-193,197-200,202-212,214,215,217-225,227-234,237-242,244-254,256,257,259-264 and 269-272.

## **DETAILED ACTION**

### ***Introduction***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' amendments and remarks filed on 6/3/2008 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

### ***Election/Restrictions***

4. Applicant's election without traverse of Species A (first layer/second layer), as set forth in claims 181 and 189 in the reply filed on 8/17/2009 is acknowledged. Claims 181-183, 185, 186, 188-193, 197-200, 202-212, 214, 215, 217-225, 227-234, 237-242, 244-254, 256, 257, 259-264, and 269-272 are elected and active. Non-elected claims 184, 194, 201, 216, 226, 236, 243, and 258 have been cancelled.

### ***Rejections Based on Prior Art***

5. Claims 181-183, 185, 186, 188-193, 197-200, 202-212, 214, 215, 217-225, 227-234, 237-242, 244-254, 256, 257, 259-264, and 269-272 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi [US 6173649].

Onishi's invention relates to printing medium. The printing medium consists of a substrate and a glossy layer and/or an ink accepting layer formed on one of the surfaces of the substrate [col. 6, ll. 65-67]. The printing medium may be any form of quality paper, such as a glossy paper, coated paper having an ink acceptable layer, etc. [col. 9, ll. 21-25]. Fig. 1 illustrates that the printing medium is provided with an easy separating means 2 for easily separating a portion of the printing medium 1 from a main portion thereof [col. 5, ll. 29-35]. The separating means 2 should allow separation (split) by hand of the cutout portions from the main portion. The separating means may be a continuous cut line. The cut line may be formed so that the depth of the cut is less than the full thickness of the substrate [col. 5, ll. 36-46; col. 7, ll. 1-6]. Fig. 18 illustrates an embodiment of a printing medium comprising a grid of four horizontal and four vertical continuous cut lines subdividing the printing medium into a plurality of portions. The cutout portion may be easily separated from the main portion by hand by repeatedly bent several times along the separating means 2 [col. 6, ll. 49-53].

For claims 181-183, 185, 186, 189, 190, 192, 193, Onishi is silent about 1) a printing medium of paper/cellulosic resin film laminate, and 2) the cut line is bent only once to split the portions apart from one another. However, regarding 1), Onishi teaches that the printing medium may be any form of quality paper, such as bond paper, PPC paper, envelope, label, dedicated coat paper having a special ink acceptable layer formed thereon, OHP film, glossy paper (film), and the like [col. 9, ll. 21-24]. Further, the examiner takes Official notice that

paper/cellulose (first layer/second layer) laminate is old and well known for forming printable cards, such as identification card, etc. It would have been an obvious selection to one of ordinary skill in the art to use a known laminate of paper/cellulosic to make the printing medium of Onishi, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. Regarding 2), since Onishi teaches generally the same structure and composition, and for the same end use as the claimed invention, and Onishi suggests forming an easy separating means as set forth above, workable configuration of the separating means, and resultant number of times of bending required for separation, including bent only once, are deemed to be obvious routine optimization to one of ordinary skill in the art, motivated by the desire to obtain an improved easy separation means.

For claim 188, Onishi illustrates in Fig. 2 of a photo bearing medium (photoreceptive medium) [col. 2, ll. 29].

For claim 191, the process limitation “the cut lines are die cut lines” has not been shown on the record to produce a patentably distinct article, the formed articles are rendered *prima facie* obvious, and this limitation at the present time has not been given patentable weight. Further, even the process limitation is considered, the examiner takes Official notice that forming a continuous cut line by die cut process is old and well known, and therefore it would have been an obvious selection to one of ordinary skill in the art.

For claims 197 and 198, Onishi’s Fig. 18 illustrates that the cut lines engage opposing edges of the printing medium.

For claim 199, Onishi teaches that the cut line may be formed so that the depth of the cut is less than the full thickness of the substrate. Forming a workable cut depth to completely cut

through the outer first layer, and partially through the second layer is deemed to be an obvious routine optimization to one of ordinary skill in the art, motivated by the desire to provide an adequate structural support for printing prior to separating for end use.

For claims 200, 202-212, 214, 215, 217-225, 227-234, 237-242, 244-254, 256, 257, 259-264, and 269-272, since they are within the same scope of claims 181-183, 185, 186, 188-193, 197-200, they are also rejected for the same reasons set forth above.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 181-183, 185, 186, 188-193, 197-200, 202-212, 214, 215, 217-225, 227-234, 237-242, 244-254, 256, 257, 259-264, and 269-272 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 26-55 and 57-73 of copending Application No. 11/134724. Although the conflicting claims are not identical,

they are not patentably distinct from each other because both the applications are directed to a multilayered laminate of paper and a polymeric support layer, with cut lines subdividing the paper into two or more portions, and that the cut line is cut into the paper layer but not entirely through the multilayered sheet.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Applicant stated in previous replies that the provisional nonstatutory obviousness-type double patenting (ODP) rejection is noted, without any argument. However, since there is no provision in the rules for holding ODP rejection in abeyance, appropriate response such as terminal disclaimer is required in next reply to avoid abandonment of the application, or being held non-responsive.

#### ***Response to Arguments***

8. Applicant's arguments directed to withdrawn references in the Remarks filed 6/3/2009 are moot.

#### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794